

## **REMARKS**

### **Introduction:**

In accordance with the foregoing, claims 21 and 26 been amended. No new matter is being presented. Therefore, claims 21, 22 and 24-26 are pending in the application and reconsideration is respectfully requested.

### **Rejections under 35 U.S.C. § 112:**

Claims 26 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite. However, claim 26 has been amended in accordance with the Examiner's comments. Thus, the rejection is believed to be overcome.

### **Rejections under 35 U.S.C. § 103(a):**

Claims 21, 22, 24-26 are rejected as obvious over Wang, Eby, Schmidle and Courtoy ('291 and '910), claims 21, 22 and 24-26 are rejected as obvious over Courtoy ('291) and Wang and claims 21, 22 and 24-26 are rejected as obvious over Courtoy ('910) and Wang. These rejections are traversed.

In Wang, the surface covering has the following structures: (1) a foamable substrate/a printing design/a first transparent layer with platey material (fig. 9), (2) a foamable substrate/a printing design/a first transparent layer 16 with platey material/a wear layer 66 (Fig. 10), (3) a foamable substrate/a first transparent layer 16 with platey material/a second transparent layer 72/a printing design and (4) a foamable substrate/a first transparent layer 16 with platey material/a second transparent layer 72/a printing design/a wear layer 66 (Fig. 11). In Wang, the embossing is chemical and the transparent layer 16, the wear layer 66 and the second translucent layer 72 are presented as being "hardenable". Because "hardenable" is not equivalent and could not be understood by one skilled in the art as "non-curable" or "curable", Wang fails to disclose

the claimed applying a first and a second ink comprising a photo-initiator, applying a non-curable layer overlying the inks and applying a curable layer overlying the non-curable layer. Moreover, it is clear that Wang, therefore, also fails also to disclose the claimed operations g) to j). In particular, Wang fails to disclose a first mechanical embossing of a curable layer overlying the non-curable layer, said embossing being fixed by the curing of the curable layer, followed by a chemical embossing (foaming of the substrate), followed by a second mechanical embossing.

In Eby, the surface covering has the following structure: a backing/a foamable layer with or without embossing/a design layer (ink)/a wear layer mechanically embossed. Therefore, Eby fails to disclose the claimed applying a first and a second ink comprising a photo-initiator, applying a non-curable layer overlying the inks and applying a curable layer overlying the non-curable layer. As above, Eby therefore also fails also to disclose the operations g) to j). Even if Eby teaches the chemical embossing of the foam layer and a mechanical embossing of the cured wear layer in col. 9, lines 9-13, Eby does not teach this for a surface covering comprising a curable wear layer overlying a non-cured layer, as claimed. Further, Eby does not teach a first mechanical embossing of the wear layer before curing the curable layer over the non-curable layer and foaming the foamable layer.

While the Examiner stated that Wang fails to disclose a “cured coating overlying the non-curable coating,” the Examiner then stated that Eby teaches a “cured coating overlying an ink,” and suggested thus that the ink of Eby is the non-curable coating of the present invention. The applicants respectfully disagree noting that for one skilled in the art, an ink is not, and could not be understood as being, the non-curable coating of the present invention. Indeed, in Eby, the layer B is an ink (col. 8, line 30 and lines 64-66) comprising foaming retarder (col. 9, line 1) and should thus be understood, and would be understood by one skilled in the art, as being merely a printing ink. The claims should be read giving the features the meaning and scope which they normally have in the relevant art as no special meaning is given for these features in the description of the present invention. The applicants are surprised by the wide interpretation made by the Examiner regarding the ink of Eby, and in fact the Examiner himself used the term “ink” for the design layer of Eby.

In the present invention, the non-curable layer is clearly distinct from the ink, and this

fact cannot just be ignored by the Examiner. Furthermore, following the reasoning of the Examiner, why would one skilled in the art not interpret the ink of Eby as being a curable layer as some inks are curable? There is no indication in Eby which could lead anyone to interpret the ink as being curable or non-curable.

In Schmidle, the surface covering has the following structure: a substrate comprising a backing material and a foamable layer/a printing composition layer/a curable wear layer. The printing composition comprises a blowing modifier and a photo-initiator. Therefore, Schmidle fails to disclose the claimed applying a second ink comprising a photo-initiator, applying a non-curable layer overlying the inks and applying a curable layer overlying the non-curable layer. Therefore, Schmidle fails also to disclose the operations g) to j). Even if Schmidle teaches a chemical embossing and the use of an ink comprising a photo-initiator to cure the wear layer, this is not suggested for a surface covering comprising a curable wear layer overlying a non-cured layer. Furthermore, Schmidle does not teach a first mechanical embossing of the wear layer before curing the curable layer over the non-curable layer and a second mechanical embossing of the wear layer after having foamed the foamable layer.

In both of the Courtoy references, the surface covering has the following structure a sheet substrate/a foamable layer/inks/a curable coating. Therefore, Courtoy fails to disclose applying a non-curable layer overlying the inks and applying a curable layer overlying the non-curable layer. Therefore, Courtoy fails also to disclose the operations g) to j). Even if Courtoy discloses a first mechanical embossing of the curable coating which has been gelled before the curing of the curable layer and foaming of the foamable layer, and a second mechanical embossing, this is not suggested for a surface covering comprising a curable wear layer overlying a non-cured layer.

Despite the fact that there is no suggestion in the references that would have prompted one skilled in the art to combine them, combining these four documents will never allow one skilled in the art to achieve a surface covering falling within the terms of the claims of the present application. Indeed, none of these documents suggesting a non-curable layer overlying an ink or a plurality of inks and onto which is applied onto a curable layer.

Thus, it is believed that base claims 21, 22 and 26 are patentably distinguished from any

combination of the references and that, therefore, the rejections of these claims as well as those of dependent claims 24 and 25 are overcome.

As an additional matter, taking into account the above mentioned teachings of each reference, the applicants submit that the Courtoy references should be considered as being the closest references instead of Wang. The Courtoy disclosures comprise the most features in common with the present invention and Wang clearly has less. The difference between the Courtoy disclosures and the invention, however, are substantial and include the presently claimed non-curable layer overlying a non-cured layer. In addition to its buffer function, i.e. limitation of the migration of the photoinitiator and expansion inhibitor, the claimed non-curable layer allows for smoothing of the unevenness of the foamable layer and leads to a difference in gloss. Indeed, during the foaming, the surface of the foamed layer presents unevenness and small bubbles, which give a matte aspect. The non-curable layer is flexible (as being non curable) and allows for elongation during foaming and a smoothing out of the unevenness.

As already mentioned, none of the references including the Courtoy disclosures suggest using a non-curable layer between an ink layer (or inks layer) and a curable layer. Regarding Wang, there is no indication in either Courtoy or Wang that would have prompted one skilled in the art to combine these documents. Furthermore, the Courtoy references deal with the combination of mechanical embossing and chemical embossing, while Wang deals with only a chemical embossing. In addition, in Wang, the embodiment represented in fig. 11 would be disregarded by the skilled man as the first transparent layer 16 and the second transparent 72 layer are provided under the ink. Regarding the embodiment of fig. 10, the first transparent layer 16 and the wear layer 66 are presented both as "hardenable", i.e. "hardenable, fluid, transparent or translucent first layer" and "second, hardenable, fluid transparent or translucent second layer", thus implicitly meaning that they are identical or at least being of identical nature, while in the present invention the non-curable and the curable are clearly different. Furthermore, Wang is silent about the fact that these layers are curable or non-curable. Regarding Eby's disclosure, one skilled in the art would disregard this teaching for the reasons already mentioned. Therefore, the set of claims should be considered as being not obvious.

**Conclusion:**

It is believed that the foregoing amendments and remarks place the application in condition for allowance and an early and favorable action to that effect is respectfully requested. The Examiner is invited to contact applicant's attorney at the below listed phone number regarding this response or otherwise concerning the present application. Applicant hereby petitions for any necessary extension of time required under 37 C.F.R. 1.136(a) or 1.136(b) which may be required for entry and consideration of the present Reply. If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,  
CANTOR COLBURN LLP  
Applicants' Attorneys

By/Howard I. Levy/  
Howard I. Levy  
Registration No. 55,378  
Customer No. 23413  
Cantor Colburn LLP

1800 Diagonal Road, Suite 510  
Alexandria, VA 22314  
Phone: 703-236-4500  
Fax: 703-236-4501  
Date: October 24, 2011